

REMARKS/ARGUMENTS:

Claims 1 – 37 are in the case.

No new matter has been added.

Withdrawal of the rejection of claims 24 and 25 under 35 USC §112, second paragraph, as being indefinite.

The withdrawal of the rejection of claims 24 and 25 is noted with appreciation.

Maintenance of the rejection of claims 1 – 3, 6 – 12, 15, 16, 18 – 20 and 22 – 37 under 35 USC §112, first paragraph, because the specification fails to set forth examples of additional pesticides that can be employed in the instant application;

With respect, examples of additional pesticides are explicitly provided in paragraph [0047] of the specification that was published as US 2004/0048833 (the original specification). At that location, a number of examples of "other pesticides" are described.

Accordingly, it is respectfully requested that the present ground of rejection be reconsidered and be withdrawn.

Withdrawal of the rejection of claims under obviousness type double patenting with respect to U.S. Patent Nos. 6,660,690 and 6,903,093:

The withdrawal of the rejection of claims under obviousness type double patenting with respect to U.S. Patent Nos. 6,660,690 and 6,903,093 is noted with appreciation.

Maintenance of the provisional rejection of claims 1 – 3, 6 – 12, 15, 16, 18 – 20, 22, 23 and 25 – 35 on the ground of nonstatutory obviousness-type double patenting over claims 9 – 13 and 15 – 23 of copending U.S. Patent Application No. 11/072,215.

It is respectfully requested that prosecution of the present claims continue until a provisional double patenting rejection based on a co-pending application such as the application noted above is the only remaining ground of rejection, and that rejection should then be withdrawn pursuant to MPEP §804(I)(B).

Maintenance of the provisional rejection of claims 1 – 3, 6 – 12, 15, 16, 18 – 20, 22, 23 and 25 – 35 on the ground of nonstatutory obviousness-type double patenting over claims 1 and 9 – 25 of copending U.S. Patent Application No. 11/028,782.

It is respectfully requested that prosecution of the present claims continue until a provisional double patenting rejection based on a co-pending application such as the application noted above is the only remaining ground of rejection, and that rejection should then be withdrawn pursuant to MPEP §804(I)(B).

Maintenance of the rejection of claims 1, 9 – 12, 15, 16, 18, 19 and 24 on the ground of nonstatutory obviousness-type double patenting over claims 1 – 4, 7, 14 – 16, 18 – 21, 24 – 29 and 31 of U.S. Patent No. 6,713, 077.

Previously, the Office argued that the cited claims of the '077 patent teach or make obvious the application of a composition comprising permethrin and an additional insecticide to seeds in order to protect developing plants from damage by pests. In response, the Applicant argued that the Office failed to show, as required, that at least one examined application claim was not patentably distinct from the referenced claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the referenced claim(s). *Eli Lilly & Co. v. Barr Labs., Inc.*, 58 USPQ2d 1869 (Fed. Cir. 2001). The Applicant pointed out that because the referenced claims of the '077 patent do not teach each and every feature of the present claims, they cannot anticipate those claims. In particular, because the reference claims do not disclose or suggest the feature of the present claims requiring that:

"... if the seed is treated with a pesticide in addition to the pyrethrin or synthetic pyrethroid, the additional pesticide is added as a part of the composition along with the pyrethrin or synthetic pyrethroid."

they cannot form the basis of a *prima facie* case of obviousness.

In response, the Office has characterized this response as an argument, "... that USPN '077 does not suggest the addition of a pesticide to the permethrin. The Office "...points applicant to column 5 lines 24 – 30 of USPN '077 where it lists suitable pesticides that can be added to the permethrin."

With respect, this mischaracterizes Applicant's argument, which is directed to the requirement quoted above, not to whether or not an additional pesticide is used with the

pyrethroid. Moreover, whether or not such information appears in the specification is irrelevant to the issue whether a claim in the '077 patent anticipates or makes obvious a claim in the present application, as is required in order to show nonstatutory obviousness type double patenting. In fact, when considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. (underline added) *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 23 USQ2d, 1839, 1846 (Fed. Cir. 1992). Thus, not only is the argument of the Office not relevant as to whether the claims of the '077 patent anticipate or make obvious the present claims, but also makes impermissible use of the specification of the '077 patent.

In summary, none of the cited claims of the '077 patent teach or suggest the feature of the present claims that requires that, if the seed is treated with a pesticide in addition to the pyrethrin or synthetic pyrethroid, the additional pesticide is added as a part of the composition along with the pyrethrin or synthetic pyrethroid, as required in the claims of the present application. Without such a teaching, the claims of the '077 patent cannot support a case of nonstatutory obviousness type double patenting over the present claims.

Accordingly, it is respectfully requested that the present ground of nonstatutory double patenting over the '077 patent be reconsidered and be withdrawn.

Rejection of claims 1 – 3, 6 and 25 – 27 under 35 USC §103(a) as being obvious over the Gatehouse *et al.* article and the Maskell *et al.* article.

It is respectfully requested that the rejection of claims 1 – 3, 6 and 25 – 27 under 35 USC §103(a) as being obvious over the Gatehouse *et al.* article and the Maskell *et al.* article be reconsidered and be withdrawn for the reasons discussed below.

The present claims require that "...if the seed is treated with a pesticide in addition to the pyrethrin or synthetic pyrethroid, the additional pesticide is added as a part of the composition along with the pyrethrin or synthetic pyrethroid".

Neither the Gatehouse *et al.* article, nor the Maskell *et al.* article teaches this feature of the claims. In fact, both articles explicitly state that when a pesticide is added to the seed in addition to the pyrethroid, it is added separately. Thus, it cannot be

added "as a part of the composition along with the pyrethrin or synthetic pyrethroid", as required in the claims.

Specifically, the Gatehouse *et al.* reference states that its winter wheat seeds were "pre-treated with a liquid organomercury fungicide ('Panogen M') at 0.75 ml kg⁻¹", and "...then treated with ...permethrin..." (last line on page 110, continuing to page 111).

The Maskell *et al.* article states that: "[a]ll wheat seed was treated with a dry powder or liquid organomercury fungicide and insecticides were added separately in an experimental churn seed dresses or in commercial seed dressing machinery." (first paragraph of the "Materials and Methods" section on page 224).

Because neither cited reference teaches, or provides a teaching, suggestion or motivation to combine the fungicide treatments with the pyrethrin/pyrethroid treatment, as the present claims require – and in fact require just the opposite --- neither the Gatehouse *et al.* reference, nor the Maskell *et al.* reference, alone or in any combination, teach or make obvious the claimed invention.

Accordingly, it is respectfully requested that the present ground of rejection be reconsidered and withdrawn.

Request for reconsideration:

It is respectfully requested that the claims be reconsidered in view of the reasons that are discussed above and be found to be allowable. If one or more of the claims are found to not be allowable, a telephone call to the undersigned would be appreciated in order to resolve any remaining issues.

Respectfully requested,

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